

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Peter C. JOHNSON II et al.	§	Confirmation No.:	1025
		§		
Serial No.:	10/765,519	§	Group Art Unit:	2143
		§		
Filed:	01/27/2004	§	Examiner:	Mark D. Fearer
		§		
For:	Instant Messaging HTTP	§	Docket No.:	200206870-1
	Gateway	§		

**REPLY BRIEF**

**Mail Stop Appeal Brief – Patents**

Date: July 27, 2010

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In the Examiner's Answer dated May 28, 2010, the Examiner maintained the previous rejections. In response, Appellants submit this Reply Brief for further consideration by the Board.

At issue is whether claims 24-26 are non-statutory subject matter under 35 U.S.C. § 101. Further, at issue is whether claims 1 and 10 are obvious under 35 U.S.C. § 103(a) over *Yairi* in view of *Samn*. Further, at issue is whether claims 18, 21 and 24 are obvious under 35 U.S.C. § 103(a) over *Yairi* in view of *Samn* and *Kay*. The text of independent claims 1, 10, 18, 21 and 24 is provided herein for convenience (emphasis added).

1. A system, comprising:
  - an HTTP gateway adapted to establish a communication link with an HTTP server; and
  - an instant messaging communication subsystem adapted to enable communication between a plurality of instant messaging user interfaces coupled to the instant messaging communication subsystem;wherein, the HTTP gateway establishes a communication link with the instant messaging communication subsystem and wherein the HTTP gateway is adapted to receive commands from the instant messaging user interfaces, convert the commands to HTTP requests, send the HTTP requests to the HTTP server, receive

HTTP responses to the HTTP requests from the HTTP server, and send the HTTP responses to the instant messaging user interfaces via the instant messaging communication subsystem;

***wherein the HTTP gateway selects said instant messaging communication subsystem from among a plurality of instant messaging communication subsystems using a configuration file of the HTTP gateway stored on the system.***

10. A method, comprising:  
transmitting commands from a plurality of instant messaging user interfaces to an HTTP gateway via an instant messaging communication subsystem;  
converting the commands to HTTP requests;  
transmitting the HTTP requests to an HTTP server;  
generating HTTP responses to the HTTP requests; and  
transmitting the HTTP responses to the instant messaging user interfaces via the instant messaging communication subsystem;  
***wherein transmitting commands from the plurality of instant messaging user interfaces to the HTTP gateway comprises accessing a configuration file to determine with which of a plurality of instant messaging communication subsystems the gateway establishes said communication link.***
18. A system comprising:  
means for establishing a communication link between an HTTP gateway and an HTTP server;  
means for transmitting commands from a plurality of instant messaging user interfaces coupled to an instant messaging communication subsystem to the HTTP gateway via at least one instant messaging bot;  
means for converting the commands to HTTP requests;  
means for transmitting the HTTP requests to the HTTP server;  
means for generating HTTP responses to the HTTP requests; and  
means for transmitting the HTTP responses via the at least one instant messaging bot to the instant messaging user interfaces;  
***wherein the HTTP gateway selects said instant messaging communication subsystem from among a plurality of instant messaging communication subsystems using a configuration file of the HTTP gateway stored on the system.***
21. A gateway, comprising:  
a CPU;  
a storage device coupled to the CPU and containing executable code;  
wherein, upon executing the code, the processor receives commands from instant messaging user interfaces, converts the commands to HTTP requests, sends the HTTP requests to an HTTP server,

receives HTTP responses from the HTTP server, and sends the HTTP responses to the instant messaging user interfaces via an instant messaging communication subsystem;

***a configuration file, wherein the CPU accesses data in the configuration file to determine with which of a plurality of instant messaging subsystems the gateway establishes a communication link;***

wherein the configuration file is usable to determine to which of a plurality of HTTP servers the gateway sends said HTTP requests.

24. A computer-readable medium comprising software that, when executed by a processor, causes the processor to:

receive commands from a plurality of instant messaging user interfaces;

convert the commands to HTTP requests;

transmit the HTTP requests to an HTTP server;

receive HTTP responses from the HTTP server; and

transmit the HTTP responses to the instant messaging user interfaces via an instant messaging communication subsystem;

***wherein receiving commands from or transmitting HTTP responses to the plurality of instant messaging user interfaces comprises accessing a configuration file to determine with which of a plurality of instant messaging communication subsystems to establish a communication link.***

## **I. § 101 REJECTIONS**

With regard to claims 24-26, the Examiner argues that the term "computer-readable medium" is non-statutory subject matter and suggests using the phrase "non-transitory computer-readable medium" instead. Appellants acknowledge that a USPTO Memo dated 01/26/10 suggests the term "computer-readable medium" is interpretable as including non-statutory signals, but submit that the USPTO Memo is misguided or is being improperly interpreted. For example, the USPTO Memo cites *In re Nuijten*, which simply states that a signal cannot be statutory subject matter. Further, MPEP § 2111.01 does not even discuss the term "computer-readable medium" as is suggested in the USPTO Memo. Further, the *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101* dated 08/24/10, also mentioned in the USPTO Memo, does not state that the term "computer-readable medium" should be interpreted as non-statutory subject matter per se. Instead, the above-noted Interim Examination Instructions state (emphasis added) that "a claim to a

computer readable medium that can be a compact disc **or a carrier wave** covers a non-statutory embodiment and therefore should be rejected under § 101 as being directed to non-statutory subject matter.” See page 2.

Appellants submit that interpreting “computer-readable medium” to cover non-statutory subject matter per se is contrary to the historical practice of the USPTO, which is to interpret a “computer-readable medium” as a statutory product claim. See *e.g.*, *Ex parte Bo Li*, Appeal 2008-1213, pages 8-9 (BPAI 2008) (“It has been the practice for a number of years that a ‘Beauregard Claim’ of this nature be considered statutory at the USPTO as a product claim”). Further, the issue raised by the Examiner was considered by the BPAI in *Ex parte Mazarra*, Appeal 2008-4741, pages 20-22. In this case, the BPAI considered the issue of whether a claim that recites “a computer useable medium” should be interpreted so broadly as to read on non-statutory subject matter, and determined that the claim term “computer usable medium” is directed to statutory subject matter unless the specification expressly states that the term “computer usable medium” is intended to include non-statutory subject matter such as signals or paper. In *Ex parte Mazarra*, the BPAI also noted that the term “computer usable medium” is not analyzed differently than the term “computer-readable medium,” which is used in claims 24-26. Appellants’ specification does not explicitly state that a “computer-readable medium” includes signals or carrier waves and, instead, refers to a tangible memory storage 320. See at least Fig. 3 and paragraph [0027]. Appellants respectfully submit that the claimed “computer-readable medium” in claims 24-26, especially in light of Appellants’ specification, should be interpreted as statutory subject matter. Based on the foregoing, Appellants respectfully request that the rejection of claims 24-26 as being non-statutory under 35 U.S.C. § 101 be reversed.

## **II. § 103 REJECTIONS**

Claims 1, 10, 18, 21 and 24 require “a configuration file” to determine which of a plurality of instant messaging communication subsystems is selected or with which a communication link is established. The Examiner alleges that the claimed configuration file is comparable to *Yairi*’s discussion of parameters stored

by a proxy module. See Examiner's Answer dated 05/28/10, page 20. Appellants disagree. With respect to the parameters mentioned by the Examiner, *Yairi* states (emphasis added):

Web service controller 107 in step 305 obtains the description metadata corresponding to the selected web service from web service database 133, ***and analyzes the metadata to determine parameters that web service proxy 103 needs to obtain from 1M client 211 in step 307 prior to sending a message to the web service provider in step 309.*** The web service metadata may indicate that web service proxy 103 only needs to send a single message to a web service provider with a single input parameter, or may indicate that multiple messages and/or multiple input parameters are needed. See paragraph [0040].

***For example, web service controller 107 obtains the web service metadata associated with the stock lookup web service from web service broker 105 and more specifically from web service database 133.*** When a WSDL description document is available, proxy 103 may identify the offered web service by the <operation> element. ***The obtained metadata may further indicate (by looking up the WSDL <part> element) that the stock lookup web service requires two parameters: 'symbol' and 'quote\_type'.*** Symbol may be used to store the ticker symbol of the requested stock quote, and quote\_type may be used to indicate whether the user desires a delayed quote (less expensive) or real time quote (more expensive). See paragraph [0041].

If the user (via 1M client) requests a composite service, then SC 107 may oversee interaction with the 1M client to obtain all the necessary parameters in order for the combined service to be performed. ***For example, a house hunting composite service might combine a house-for-sale-service with a mortgage-service. The parameters needed for the combined service might be a desired location (e.g., Boston), mortgage type (e.g., 30 years fixed), and the monthly payment willing to pay.*** See paragraph [0044].

To summarize, the parameters mentioned in *Yairi* designate information fields for a particular web service (e.g., a stock lookup web service uses the parameters: "symbol" and "quote type"). In contrast to *Yairi's* parameters,

Appellants' configuration file is for selecting (or establishing a communication link with) one of a plurality of instant messaging communication subsystems.

The claimed "instant messaging communication subsystems" in claims 1, 10, 18, 21 and 24 correspond to the IM infrastructures 200 described in Appellants' specification as follows:

Referring now to Fig. 1, a representative embodiment is shown of an Instant Messaging (IM) HTTP gateway 100 for linking an IM infrastructure 200 and an HTTP server 300. See paragraph [0013].

Each IM infrastructure 200 (such as Yahoo Messenger or ICQ Instant Messenger) may use a uniquely formatted data request that is used by IM user 210 to send requests to IM HTTP gateway 100. See paragraph [0014].

In operation, the IM HTTP gateway 100 may read a configuration file, which may be stored on the computer or server housing the gateway 100. The configuration file informs IM HTTP gateway 100 which IM infrastructure(s) 200 to log in to, and which bots to use for that particular login. See paragraph [0015].

*Yairi's* parameters are not part of a configuration file and are not used to select between a plurality of instant messaging communication subsystems as is required in claims 1, 10, 18, 21 and 24. Instead, *Yairi's* parameters define an information field(s) compatible with a particular web service. *Yairi's* information field is filled in by a user or is filled in automatically. See paragraph [0043]. *Samn* and *Kay* are likewise deficient with regard to the configuration file limitation and thus a *prima facie* case of obviousness has not been properly established against claims 1, 10, 18, 21 and 24. Based on the foregoing, Appellants respectfully request that the rejection of claims 1, 10, 18, 21 and 24 and their dependent claims as obvious over *Yairi* and *Samn* (or *Yairi*, *Samn* and *Kay*) be reversed.

### **III. CONCLUSIONS**

For the reasons stated above as well as in Appellants' principle brief, Appellants respectfully submit that the Examiner erred in rejecting all pending claims. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this

**Appl. No. 10/765,519**  
**Reply Brief dated July 27, 2010**  
**Reply to Examiner's Answer of May 28, 2010**

paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

/Alan D. Christenson/

---

Alan D. Christenson  
PTO Reg. No. 54,036  
CONLEY ROSE, P.C.  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)  
ATTORNEY FOR APPELLANTS

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
Legal Dept., M/S 35  
3404 E. Harmony Road  
Fort Collins, CO 80528